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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,658	03/17/2004	Rodrick A. HERDMAN	EZL-001M	2657
26868 7590 02/09/2007 HASSE & NESBITT LLC 8837 CHAPEL SQUARE DRIVE SUITE C CINCINNATI, OH 45249			EXAMINER GALL, LLOYD A	
			ART UNIT	PAPER NUMBER
			3676	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/708,658

Applicant(s)

HERDMAN, RODRICK A.

Examiner

Lloyd A. Gall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-15,22-25,27,28 and 44-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-15,22-25,27,28 and 44-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17-March 2004 and 09 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date <u>1/5/05; 10/5/06</u>   | 6) <input type="checkbox"/> Other: _____                           |

### DETAILED ACTION

In response to applicant's traversal of the restriction requirement with respect to the claims 24, 25, 27 and 28 filed on January 9, 2006, the restriction requirement is withdrawn, and claims 24, 25, 27 and 28 are also examined on their merits, as follows.

The disclosure is objected to because of the following informalities: In paragraph [0170], line 28 through the remainder of the paragraph, reference numerals 30a and 62a do not correspond to the figures. In paragraph [0192], line 1, "23 28" is grammatically incorrect. In paragraph [0225], line 10, the terminology following "30d" is unclear

Appropriate correction is required.

Applicant should note that an initialed copy of PTO-1449 filed on January 5, 2005 is attached to this Office action, since the "Master Lock Brochure" was not previously initialed by the examiner.

Claims 6, 7, 25, 27, 28 and 59 are objected to because of the following informalities: In claim 6, line 8, "a subset" should read --the subset--. In claim 6, line 10, the double bracket should follow "position" in line 9. In claim 6, lines 13-16 are not understood, since it is not clear how the lock is reconfigured for the second key by insertion and rotation of the same second key. Wouldn't the lock already be configured for operation by the second key, if such second key can be inserted and rotated? For the same reason, claim 59 is not clear, since the lock would already seem to be configured for the first key operation if the first key can be inserted and rotated. Explain.

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In claim 7, line 2, consistency should be maintained between "of keys" and "of user keys". In claim 25, line 3, "the change member" is unclear, since claim 24, line 5 claims at least a first and a second change member. This objection also applies to claim 27, line 2 and claim 28, line 1. In claim 27, line 2, "passage" should be replaced with -- orifice--. Appropriate correction is required.

Claims 1-4, 6-15, 22-25, 27, 28 and 44-67 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/178,627. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-20 of the '627 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-4, 6-15, 22-25, 27, 28 and 44-67 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 21 and 22 of copending Application No. 11/192,755. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially claim the same subject matter, and claims 1-17, 21 and 22 of the '755 application fully encompass the subject matter of the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Applicant should also note that with respect to the rejection on page 3, lines 11-12 of the Office action of September 21, 2006, the change tool is assumed by the examiner in the claims to be positively claimed.

In view of the above objections to the claims, the respective claims are rejected as best understood, on prior art, as follows.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8-12, 22, 55, 58 and 59 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Monahan (002).

Monahan teaches all of the claimed limitations, including a housing 30, a plug 34, springs 49, drivers 44, pins 45, plural keys with different (raised and lowered) contour edges received in keyway passage 62, a change tool slot 52, a change tool 51, change members 47 moved by the change tool as seen in figure 14 after the plug is rotated. With respect to claim 22, Monahan also teaches a shim defined by the topmost wafer 47 as seen in figure 12. With respect to paragraph "d)" of claim 6, the lock of Monahan is capable of being reconfigured solely in response to a key, by removing the change tool such as in the figure 11 condition, and then inserting a key, rotating the key, and allowing a change member 47 to fall within the retainer cavity.

Claims 7, 13-15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (188).

As seen in the figures 88-99 embodiment and in column 31, line 25 through column 32, line 60, Smith teaches all of the article and method limitations of claims 7, 13-15 and 24, including a plurality of keys U1, U2, M2 having contour edges with raised and lowered contour locations, a housing 510, a plug 520, retainer cavities 545, 546, a plurality of change members 571, 581, a shim 583 in figure 94 of a larger diameter, wherein the lock is reconfigured solely by insertion of a key, and rotation of a key to reposition a change member 571, 581 from its first position (fig. 91) in the plug to a second position (fig. 93) in the plug in a retainer cavity 546 upon rotation of the plug away from its first position into its second position. With respect to claim 24, as set forth in column 31, line

25 through column 32, line 60, plural keys are used in this process to reconfigure the lock.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Monahan (002) in view of Smith (188).

Monahan has been discussed above. In figure 94, Smith teaches a shim 583 of a first diameter and a retainer cavity 545 of a second, smaller diameter. It would have been obvious to use a larger diameter shim with a retainer cavity of Monahan, in view of the teaching of Smith, the motivation being to control how many change members may enter a change cavity, in reprogramming a lock.

Claims 6, 8-12, 22, 23, 25, 27, 28, 55, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (188) in view of Monahan (002).

As seen in the figures 88-99 embodiment and in column 31, line 25 through column 32, line 60, Smith teaches all of the article and method limitations of claims 7, 13-15 and 24, including a plurality of keys U1, U2, M2 having contour edges with raised and lowered contour locations, a housing 510, a plug 520, retainer cavities 545, 546, a plurality of change members 571, 581, a shim 583 in figure 94 of a larger diameter, wherein the lock is reconfigured solely by insertion of a key, and rotation of a key to reposition a change member 571, 581 from its first position (fig. 91) in the plug to a second position

(fig. 93) in the plug in a retainer cavity 546 upon rotation of the plug away from its first position into its second position. With respect to claim 24, as set forth in column 31, line 25 through column 32, line 60, plural keys are used in this process to reconfigure the lock. Monahan has been discussed above, and includes a change tool slot and a change tool which may be used with retainer cavities and change members to aid in reprogramming a lock, by moving the change members from their position in the retainer cavities into the housing of the lock, as seen in fig. 13 of Monahan. It would have been obvious to modify the lock of Smith to include a change tool and change tool slot to be used with its retainer cavities and change members, in view of the teaching of Monahan, the motivation being to simplify reprogramming of the lock.

Provided the above double patenting rejections are overcome, claims 1-4, 44-54 and 60-67 would be allowable. Further, claims 56 and 57 would be allowable if rewritten in independent form.

Applicant's arguments with respect to claims 1-4, 6-15, 22-28 and 44-67 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

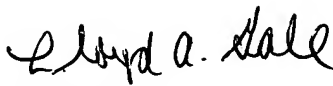
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LG LG  
February 2, 2007

  
Lloyd A. Gall  
Primary Examiner